

REMARKS

Claims 1-30 are pending in this application.

Claims 1-30 have been rejected.

No claims have been amended.

Reconsideration and full allowance of Claims 1-30 are respectfully requested.

I. PREVIOUSLY ALLOWABLE CLAIMS

The Applicants note that in view of new prior art the Examiner has rejected previously allowable Claims 10, 20, and 30. For the reasons set forth below, the Applicants respectfully submit that Claims 10, 20, and 30 (and all other pending claims) are allowable. As a result, previously allowable Claims 10, 20 and 30 remain in condition for allowance.

II. REJECTIONS UNDER 35 U.S.C. § 103(a)

The Office Action rejects Claims 1-2, 5-12, 15-22, and 25-30 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,067,525 to Johnson et al. (hereafter “*Johnson*”) in view of United States Patent No. 5,987,422 to Buzsaki (“*Buzsaki*”). The Office Action also rejects Claims 3-4, 13-14, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* and *Buzsaki* in view of United States Patent No. 6,073,109 to Flores et al. (hereafter “*Flores*”). The Applicants respectfully traverse these rejections.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260,

1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The Applicants respectfully direct the Examiner's attention to Claim 1, which sets forth unique and novel claim elements:

1. (Previously Presented) For use in connection with a network capable of providing communications between a plurality of customers generating service requests and a plurality of vendors capable of fulfilling said service requests, a system for monitoring and controlling work flows associated with said service requests between said plurality of customers and said plurality of vendors comprising:

a main controller capable of creating a first work flow record used to control a first work flow associated with a first service request and storing said first work flow record in a storage device associated with said main controller, wherein said main controller is further capable of receiving from a first customer within said plurality of customers and a first vendor within said plurality of vendors, said first customer and said first vendor associated with said first work flow, at least one of messages, data files, software applications, and documents, storing said at least one of messages, data files, software applications, and documents in said storage device in association with said work record, and transferring at least one of said at least one of messages, data files, software applications, and documents to at least one of said first customer and said first vendor, wherein said first work flow is at least partially developed or executed by said receiving, storing and transferring said at least one of messages, data files, software and documents; and

an accounting controller associated with said main controller capable of identifying at least one fee associated with said first work flow and storing fee data associated with said at least one fee in said first work flow record. (Emphasis added).

With respect to independent Claim 1, the Examiner stated that "As per claim 1-2, 5-10 and 15-16, 19-22, Johnson discloses a method for facilitating a transaction between a plurality of buyers and sellers comprising:" (Office Action, Page 2, Lines 20-21). The Applicants respectfully disagree with the Examiner's characterization of the *Johnson* reference as disclosing "a method for facilitating a transaction between a plurality of buyers and sellers."

The *Johnson* reference discloses "a computer sales system which is used to facilitate a sales process." (*Johnson*, Column 2, Lines 24-25). The *Johnson* computerized sales system

comprises a plurality of subsystems, each of which electronically facilitate an event that occurs during the sales process. (*Johnson*, Column 2, Lines 46-47). One of the subsystems is referred to as a “Time with Customer component 104.” (*Johnson*, Column 3, Line 66).

It is clear that the *Johnson* system does not facilitate a transaction between “a plurality of buyers and sellers” because the *Johnson* system deals with only one customer at a time. For example, the *Johnson* system “assists salespeople in generating revenue by committing a customer to a specific purchase, i.e., converting the “lead” into a purchasing customer.” (Emphasis added). (*Johnson*, Column 4, Lines 61-63). The “presentation and proposal modules” of the *Johnson* system (including the “time with customer component 104”) “assist the sales personnel to electronically give a presentation to a customer and prepare a proposal for the customer which reflects the presentation.” (Emphasis added) (*Johnson*, Column 5, Lines 1-4).

Unlike the Applicants’ invention, the *Johnson* reference does not disclose the concept of monitoring and controlling work flows associated with service requests between a plurality of customers and a plurality of vendors. The *Johnson* system only handles one customer (and one vendor) at a time.

In the *Johnson* system, “any information related to the customer’s specific needs or desires gleaned from the customer during the time with the customer phase of the sales process may be used by the order management component 106 to ensure the needs and desires are met.” (Emphasis added) (*Johnson*, Column 5, Lines 43-47). The *Johnson* system provides a specific time period (referred to as the “time with the customer phase”) to obtain order information from

one customer. There is nothing in the *Johnson* system that relates to a plurality of customers or to a plurality of vendors.

The Examiner also stated that the *Johnson* system discloses a “central controller transmitting messages between the sellers and buyers regarding the status record of the purchase order (col. 18, lines 11-16).” (Office Action, Page 3, Lines 2-3). The Applicants respectfully traverse this assertion of the Examiner. The “order status module 504” of the *Johnson* system does not transmit messages to “sellers and buyers” regarding the status record of the purchase order. “An order status module 504 is provided to allow the salesperson to inquire and monitor the status of an order at any time throughout the order process.” (Emphasis added) (*Johnson*, Column 18, Lines 11-12). The order status in the *Johnson* system may be accessed by a salesperson. There is nothing in the *Johnson* system that relates to transmitting messages between “sellers and buyers” regarding the status record of a purchase order.

The Examiner also stated that the *Johnson* system discloses a main controller that “is further capable of receiving from a first customer and a first vendor associated with said first work flow at least one of messages, storing said at least one of messages, in said storage device, and transferring at least one of said at least one of messages, to at least one of said first customer and said first vendor (col. 29, lines 21-47).” (Office Action, Page 3, Lines 4-8). The Applicants also respectfully traverse this assertion of the Examiner for the following reasons.

The sales process set forth and described in Column 29 of the *Johnson* reference does not receive a message (or other information) from a first customer within a plurality of customers. The sales process set forth and described in Column 29 of the *Johnson* reference does not receive

a message (or other information) from a first vendor within a plurality of vendors. The system set forth and described in Column 29 of the *Johnson* reference does not transfer a message (or other information) to a first customer within a plurality of customer or to a first vendor within a plurality of vendors.

The Applicants respectfully note that the *Johnson* reference fails to disclose significant elements of the Applicants' invention. Therefore, the *Johnson* reference provides an insufficient basis for use as a prior art reference against the Applicants' invention.

The Office Action acknowledges that *Johnson* fails to disclose "executing a workflow upon receiving a message." (Office Action, Page 3, Lines 12-13). In effect, the Office Action is acknowledging that *Johnson* fails to disclose "creating a first work flow record used to control a first work flow associated with a first service request," where the first work flow is "at least partially developed or executed" by "receiving, storing and transferring" at least one of "messages, data files, software and documents" as recited in Claims 1, 11, and 21.

The Office Action then asserts that *Buzsaki* discloses these elements of the claims and that it would be obvious to modify *Johnson* with the recitations of *Buzsaki*. (Office Action, Page 3, 14-16). The Applicants respectfully traverse these assertions.

Buzsaki recites a method for executing a workflow that requires input from a role. (Abstract). The term "role" refers to one or more persons who must be notified in order to complete a particular operation within a workflow. (*Buzsaki*, Column 1, Lines 35-36). The workflow is executed until an operation requiring input from a role is detected. (Abstract). A request for input is communicated to the role, and the workflow continues once the input from

the role is received. (Abstract).

The Office Action asserts that it would be obvious to modify *Johnson* with the recitations of *Buzsaki* “so that an input from a role is solicited and processed in a smooth and efficient manner.” (Office Action, Page 3, Lines 14-18). However, *Johnson* lacks any mention of using workflows that require input from roles. The Office Action has not provided any motivation or suggestion as to why one skilled in the art would modify *Johnson* to include the use of workflows that require input from roles. In other words, while the Office Action asserts that using *Buzsaki* allows “input from a role” to be solicited and processed “in a smooth and efficient manner” for a workflow, the Office Action fails to establish that this functionality is needed or even desired in the system of *Johnson*. Without that showing, the Office Action cannot establish that a person skilled in the art would modify *Johnson* with the recitations of *Buzsaki* as asserted in the Office Action.

The *Buzsaki* reference specifically recites that workflows often represent processes used in modern businesses. (*Buzsaki*, Column 1, Lines 12-14). There is no suggestion or motivation in either the *Johnson* reference or the *Buzsaki* reference for the *Johnson* system to process the “input from a role” workflows of *Buzsaki*. As a result, the Office Action has not established that a person skilled in the art would modify the *Johnson* system to create and use a “work flow record” to control a “first work flow” that is “at least partially developed or executed” as recited in Claims 1, 11, and 21.

There is nothing in the *Johnson* reference that suggests combining the teachings of the *Buzsaki* reference with the teachings of the *Johnson* reference. There is nothing in the *Buzsaki*

reference that suggests combining the teachings of the *Johnson* reference with the teachings of the *Buzsaki* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The concept of processing an “input from a role” “in a smooth and efficient manner” for a workflow is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings.

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) (“It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references.”); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Rouffett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a

blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

The Applicants respectfully submit that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicants respectfully submit that the alleged motivation to combine references is not clear and particular. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Applicants respectfully submit that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Applicants’ invention.

For the reasons previously set forth, the Applicants respectfully disagree with the Examiner’s characterization of the *Johnson* system as set forth in the *Johnson* reference. Therefore, even if it were proper (which the Applicants do not admit) to combine the *Johnson* system and the *Buzsaki* system, the combination of the two references would still not teach, suggest or even hint at the Applicants’ invention.

Therefore, the Applicants’ invention would not have been obvious in view of the teachings of the *Johnson* reference in view of the *Buzsaki* reference. The Applicants respectfully submit that Claims 1, 11 and 21 each contain unique and novel claim limitations and that Claims 1, 11 and 21 are now in condition for allowance. Further, the dependent claims that depend, directly or indirectly, on independent Claims 1, 11 and 21 also contain the unique and

novel claim limitation of their respective independent claims. Therefore, the dependent claims that depend, directly or indirectly, on Claims 1, 11 and 21 also contain patentable subject matter and are in condition for allowance.

The Examiner also rejected Claims 3-4, 13-14, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over the *Johnson* reference and the *Buzsaki* reference in view of United States Patent No. 6,073,109 to *Flores*.

The Applicants hereby incorporate by reference all of the arguments previously made in connection with Applicants' position concerning the *Johnson* reference and the *Buzsaki* reference.

The Applicants respectfully traverse the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of *Johnson* and *Buzsaki* to include a workflow definitions modification as taught by *Flores*.

First, the supposed motivation to obtain "to create, modify and delete definition documents in a database" is very general and does not specifically suggest combining the teachings of the *Flores* reference with the teachings of the *Johnson* reference and the *Buzsaki* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire "to create, modify and delete definition documents in a database" is too general and vague to provide the requisite motivation to modify a reference or

to combine reference teachings. The *Flores* reference does not disclose any features that would cure the deficiencies of the *Johnson* reference or the deficiencies of the *Buzsaki* reference.

For these reasons, the Office Action has not shown that a person skilled in the art would be motivated to combine *Johnson* and *Buzsaki* references or be motivated to combine the *Johnson* and *Buzsaki* and *Flores* references as asserted in the Office Action. As a result, the Office Action has not established a *prima facie* case of obviousness against Claims 1-30. Accordingly, the Applicants respectfully submit that Claims 1-30 are in condition for allowance. Allowance of Claims 1-30 is respectfully requested.

III. CONCLUSION

The Applicants' attorney has made the arguments set forth above in order to place this application in condition for allowance. In the alternative, the Applicants' attorney has made the amendments and arguments to properly frame the issues for appeal. In this Response, the Applicants make no admission concerning any now moot rejection or objection, and affirmatively deny any position, statement or averment of the Examiner that was not specifically addressed herein.

SUMMARY

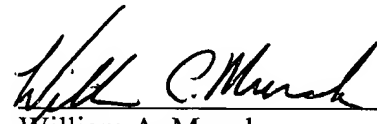
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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